

Docket No. 500.40766X00  
Serial No 09/982,291  
Office Action dated April 21, 2006

## **REMARKS**

### **I. Introduction**

By the present Amendment, claims 16, 17, and 41 have been amended. No claims have been added or canceled. Accordingly, claims 16-29, 41, 42, and 50-54 remain pending in the application. Claims 16, 17, 20, 22, 41, 42, and 50 are independent.

### **II. Office Action Summary**

In the Office Action of April 21, 2006, affirmation of the election made by telephone on March 31, 2006 was requested. Claims 16-19 and 41 were rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,707,774 issued to Kuroda et al. ("Kuroda") in view of U.S. Patent No. 6,771,885 issued to Agnihotri et al. (Agnihotri). Claims 20-25, 42, and 50 were rejected under 35 USC §103(a) as being unpatentable over Kuroda in view of Agnihotri, and further in view of U.S. Patent No. 6,034,832 issued to Ichimura et al. ("Ichimura"). Claims 26-29 and 51-54 were rejected under 35 USC §103(a) as being unpatentable over Kuroda, in view of Agnihotri and further in view of Ichimura, and still further in view of U.S. Patent No. 6,584,552 issued to Kuno et al. ("Kuno"). These rejections are respectfully traversed.

### **III. Election/Restriction Requirement**

Further to the telephone of March 31, 2006, Applicants elect, with traverse, Group II (as defined by claims 16-29, 41, 42, and 50-54) for examination at this time.

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#### **IV. Rejections Under 35 USC §103**

Claims 16-19 and 41 were rejected under 35 USC §103(a) as being unpatentable over Kuroda in view of Agnihotri. Regarding this rejection, the Office Action alleges that Kuroda discloses a digital information recording apparatus that comprises a recording circuit for recording information of a copy permission period included in the digital information and indicating a period for permitting the digital information recorded on the first recording medium to be copied and recorded only once from the first recording medium onto the second recording. The Office Action admits that Kuroda fails to particularly specify the capability of the apparatus to perform programmed or preset recordings. The Office Action indicates that the programmed recording is being interpreted as the time that the copying can take place. The Office Action relies on Agnihotri for teaching the ability for the user to program the recording apparatus to perform recording of the video program for a certain defined period of time. The Office Action concludes that the copy permission period is interpreted to be the period of time that the recording apparatus is able to perform the recording. Applicants respectfully disagree.

Independent claim 16 defines a digital information recording apparatus for recording digital information that includes video information and/or audio information on a first recording medium. The recording apparatus comprises:

a recording circuit for recording information of a copy permission period included in said digital information;

said copy permission period specifying a predetermined time period for permitting said digital information recorded on said first recording medium to be copied and recorded only once from said first recording medium onto a second recording medium different from said first recording medium after recording of said digital information on said first recording medium.

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According to the recording apparatus of claim 16, a recording circuit is used for recording information of a copy period included in the digital information. The copy permission period specifies a predetermined time period during which the digital information recorded on the first recording medium can be copied onto a second recording medium that is different from the first recording medium. Additionally, the digital information permits the recording to be performed only once from the first recording medium to the second recording medium. As discussed in the Specification, the copy permission period defines a time period during which copies can be made. After expiration of this time period, additional copies are prevented from being made. See page 7, lines 4-24 of the specification. Thus, the apparatus of independent claim 16 restricts users from making copies in two ways. First, it allows only one copy of the information stored on the recording medium to be made. Additionally, it sets a specific length of time during which this copy can be made. Accordingly, if the period of time expires, the user is prevented from making copies even if a first copy has not been made.

The Office Action alleges that Kuroda discloses a copy permission period as well as copy protection. However, Kuroda appears to teach a recording apparatus that allows the user to record a broadcast television program. Kuroda does not place restrictions on copying of information that is already stored on the first recording medium, which would be the broadcast program as interpreted by the Office Action. Further, while Kuroda discloses copy protection in the form of CGMS, Kuroda does not combine copy protection with a copy permission period (i.e., a time-based criteria). Furthermore, Applicants' review of Agnihotri has failed to reveal any disclosure, or suggestion, for a copy protection period as set forth in the claimed

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invention. Agnihotri appears to provide an uninhibited ability to record video programs.

While the cited references allow recording of video programs, they do not provide a copy permission period as set forth in independent claim 16. For example, even though a particular program may only be transmitted during a specified broadcast time. The apparatus is not prevented from actually recording. The specific broadcast may not be recorded, but the apparatus will still perform the recording function. This is entirely different from the claimed invention wherein the time period defined by the copy permission period relates to information that is already recorded on a recording medium.

The applied references simply fail to provide any disclosure or suggestion for features of the claimed invention such as "said copy permission period specifying a predetermined time period for permitting said digital information recorded on said first recording medium to be copied and recorded only once from said first recording medium onto a second recording medium different from said first recording medium after recording of said digital information on said first recording medium."

It is therefore respectfully submitted that independent claim 16 is allowable over the art of record.

Independent claim 17 defines a digital information reproducing apparatus for reproducing digital information, including video information and audio information from a first recording medium. The digital information includes information of a copy permission period that specifies a predetermined period of time for permitting the digital information to be played back and recorded only once from the first recording medium to a second recording medium. The apparatus comprises:

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a detection circuit for detecting said copy permission period from the reproduced digital information; and

a control circuit for controlling, on the basis of the information of said copy permission period detected by said detection circuit, an operation for delivering the played back digital information to said second recording medium so as to copy and record said played back digital information onto said second recording medium.

Similar to independent claim 16, the digital information reproducing apparatus of independent claim 17 utilizes a copy permission period that specifies a predetermined time period during which the digital information can be played back and recorded from the first recording medium to a second recording medium. As previously discussed with respect to independent claim 16, this particular feature is not shown or suggested by the art of record.

It is therefore respectfully submitted that independent claim 17 is allowable over the art of record.

Claims 18, 19, and 23 depend from independent claim 17, and are therefore believed allowable for at least the reasons set forth above with respect to independent claim 17. In addition, these claims each introduce novel elements that independently render them patentable over the art of record.

Independent claim 41 defines a digital information transmitting apparatus for transmitting digital information including video information and/or audio information to a recording and reproducing unit that comprises a first recording medium. The apparatus comprises:

a transmitting circuit for transmitting information of a copy permission period included in said digital information;

said copy permission period specifying a predetermined time period for permitting said digital information to be only once copied and recorded onto a second recording medium different from said first

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recording medium following recording of said digital information on said first recording medium.

Similar to independent claim 16, the digital information transmitting apparatus of independent claim 41 includes a copy permission period that specifies a predetermined time period during which digital information can be recorded onto a second recording medium. As previously discussed, the art of record simply fails to provide any disclosure or suggestion for such a feature.

It is therefore respectfully submitted that independent claim 41 is allowable over the art of record.

Claims 20-25, 42, and 50 were rejected under 35 USC §103(a) as being unpatentable over Kuroda in view of Agnihotri, and further in view of Ichimura. Regarding this rejection, the Office Action alleges that Kuroda discloses a digital information recording apparatus that comprises a recording circuit for recording information of move permission included in the digital information. The Office Action also indicates that the move permission permits recording of digital information onto a second recording medium even when the digital information is recorded on the first recording medium and thereafter inhibited from being copied and recorded onto a second medium.

The Office Action admits that Kuroda does not disclose specifying the ability to perform programmed or preset recordings. But, the Office Action interprets programmed recording to be a period of time during which copying can take place. The Office Action also admits that Kuroda fails to teach that the video program from the first medium is at least partly disabled for reproduction. Agnihotri is relied upon for teaching the ability for the user to program the recording apparatus to perform recording of a video program for a certain defined period of time. The Office Action

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relies on Ichimura as teaching that when a video program is reproduced and copied from a first medium, renewed copy protection is rewritten on the first medium and thereby no more copies are allowed and the first medium is inhibited from reproduction. Applicants respectfully disagree.

Independent claim 20 defines a digital information recording apparatus for recording digital information including video information and/or audio information on a first recording medium. The recording apparatus comprises:

a recording circuit for recording information of move permission included in said digital information and permitting, even when said digital information is recorded on said first recording medium and thereafter inhibited from being copied and recorded onto a second recording medium different from said first recording medium, said digital information to be moved to said second recording medium on the premise that at least a part of said digital information on said first recording medium is to be disabled for reproduction.

According to independent claim 20, the recording apparatus includes a recording circuit that records information concerning move permission included in the digital information. The move permission allows the digital information to be moved to a second recording medium even when the digital information recorded on the first recording medium has been inhibited from being copied and recorded on another recording medium. The move permission controls this under the premise that at least a part of the digital information on the first recording medium will be disabled for reproduction.

As discussed in the specification, the move permission allows a move operation to be performed on the digital information from one recording medium to another under various conditions, without unduly inconveniencing the user. By disabling at least part of the digital information on the recording medium, the present

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invention insures that only one working copy the digital information is in the possession of the user. As can be appreciated, there are certain situations that can require moving the digital information to a different recording medium. At least one such situation is damage to the surface of the recording medium that is at risk of propagating to the point where the digital information becomes unreadable by an appropriate device. Rather than subjecting the user to a total loss of their digital information, the invention defined by independent claim 20 allows the user to transfer the digital information to an undamaged recording medium.

The Office Action alleges that the cited references disclose the features of independent claim 20. Again, Applicants note that the ability to record a broadcast program differs from the features of the present invention. In particular, the use of a move permission, as recited in independent claim 20, allows the digital information to be moved from a first recording medium to another, and not from the broadcast device to a first recording medium. Additionally, at least part of the digital information on the first recording medium is disabled for reproduction. In contrast, the applied references could not disable the broadcast program. Further, the move permission allows the digital information to be moved from a first recording medium to a second recording medium even when the first recording medium has been inhibited from being copied. None of the references even suggests that digital information stored on a recording medium containing a copy protection can be copied to a second recording medium under certain circumstances.

The art of record simply fails to provide any disclosure or suggestion for features recited in independent claim 20, such as "a recording circuit for recording information of move permission included in said digital information and permitting, even when said digital information is recorded on said first recording medium and



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thereafter inhibited from being copied and recorded onto a second recording medium different from said first recording medium, said digital information to be moved to said second recording medium on the premise that at least a part of said digital information on said first recording medium is to be disabled for reproduction."

It is therefore respectfully submitted that independent claim 20 is allowable over the art of record.

Claim 21 depends from independent claim 20, and is therefore believed allowable for at least the reasons set forth above with respect to independent claim 20. In addition, this claim introduces novel elements that independently renders it patentable over the art of record.

Independent claim 22 defines a digital information reproducing apparatus for reproducing digital information. According to at least one feature, move permission information is included in digital information stored on a recording medium. The move permission allows the digital information to be moved to a second recording medium even when the digital information recorded on the first recording medium has been inhibited from being copied and recorded on another recording medium. As previously discussed with respect to independent claim 20, the art of record fails to provide any disclosure or suggestion for move permission information.

It is therefore respectfully submitted that independent claim 22 is allowable over the art of record.

Claims 24-29 depend from independent claim 22, and are therefore believed allowable for at least the reasons set forth above with respect to independent claim 22. In addition, these claims each introduce novel elements that independently render them patentable over the art of record.

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Independent claim 42 defines a digital information transmitting apparatus for transmitting digital information to a recording and reproducing unit having a first recording medium. The apparatus comprises:

a transmitting circuit for transmitting, even when the digital information is inhibited from being copied and recorded onto a second recording medium different from said first recording medium after said digital information has been recorded on said first recording medium, move permission information, included in said digital information, for permitting said digital information to be moved to said second recording medium on the premise that at least a part of the digital information on said first recording medium is disabled for reproduction.

Independent claim 42 recites features that are somewhat similar to those recited in independent claim 20. In particular, move permission information included in the digital information is used to permit the digital information to be moved to a second recording medium. As previously discussed, the art of record fails to provide any disclosure or suggestion for move information as set forth in the present invention.

It is therefore respectfully submitted that independent claim 42 is allowable over the art of record.

Independent claim 50 defines a digital information reproducing apparatus for reproducing digital information from a first recording medium. The apparatus comprises:

a control circuit for controlling, even when said digital information is inhibited from being copied and recorded onto a second recording medium different from said first recording medium after said digital information has been recorded on said first recording medium, an operation for delivering said digital information for the purpose of moving said digital information to said second recording medium on the premise that at least a part of said digital information on said first recording medium is disabled for reproduction; and

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a reproduction disable circuit for disabling at least a part of said digital information on said first recording medium from being reproduced.

According to independent claim 50, the apparatus includes a control circuit that controls an operation of moving the digital information to a second recording medium. This is done on the premise that at least part of the digital information on the first recording medium is disabled for reproduction. A reproduction disable circuit is also provided to disable at least part of the digital information on the first recording medium from being reproduced. This is somewhat similar to implementation of the move permission. As previously discussed, the art of record fails to provide any disclosure or suggestion for such a feature.

It is therefore respectfully submitted that independent claim 50 is allowable over the art of record.

Claims 51-54 depend, either directly or indirectly, from independent claim 50, and are therefore believed allowable for at least the reasons set forth above with respect to independent claim 50. In addition, these claims each introduce novel elements that independently render them patentable over the art of record.

#### **V. Conclusion**

For the reasons stated above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a Notice of Allowance is believed in order, and courteously solicited.

If the Examiner believes that there are any matters which can be resolved by way of either a personal or telephone interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.


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**AUTHORIZATION**

Applicants request any shortage or excess in fees in connection with the filing of this paper, including extension of time fees, and for which no other form of payment is offered, be charged or credited to Deposit Account No. 01-2135 (Case: 500.40766X00).

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP.

  
Leonid D. Thern  
Registration No. 39,397

LDT/wr  
1300 N. Seventeenth Street  
Suite 1800  
Arlington, Virginia 22209  
Tel: 703-312-6600  
Fax: 703-312-6666

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